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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,241

07/15/2003

Harry D. Lewis

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07/21/2008

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EXAMINER

THOMPSON, MICHAEL M

ART UNIT

PAPER NUMBER

3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,241	<b>Applicant(s)</b> LEWIS, HARRY D.	
	<b>Examiner</b> Michael M. Thompson	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☒ Claim(s) 1 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments with respect to claims 1 and 3-15 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

### ***Claim Objections***

2. Claims 1 and 11 are objected to because of the following informalities: Both claims appear to have misspelled the term "compliant" as "complaint". Appropriate correction is required. Applicant might review the application for the same misspelling in other locations.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In the claims the term "interactive means" and "means for a covered entity" appear to lack support in the specification. With respect to the "interactive means" and "means for a covered entity" in claims 3, 7-8 and 12-13, 37 CFR 1.75(d)(1) provides, in part, that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." In the situation in

Art Unit: 3629

which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what structure, materials, or acts perform the function recited in a means- (or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly recites what structure, materials, or acts perform the function recited in the claim element; or (B) state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP § 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element. The examiner would like clarification as to which structure, materials, or acts perform the functions as recited in the claims. No new matter should be added.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 7-8 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. When the examiner considers the “interactive

means” and “means for a covered entity” under sixth paragraph, the scope of the claims is unclear so as not to insure that the public is informed of the boundaries of what constitutes infringement of the patent. Furthermore, it is unclear as to what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. MPEP 2173

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 3-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keinsley et al. (US 2003/0154403) in view of Smithies (5,818,955) and further in view of 65 Fed. Reg. 82796 (Dec. 28, 2000).**

8. **With respect to claims 1 and 4**, Keinsley et al. teaches a method for creating and managing multilateral contractual relationships (ie. Para. 0176) among contracting parties under a privacy standard (ie. HIPAA regulations inherently require privacy standards, ie. Para. 0118-0121), said contracting parties comprising (1) "covered entities" receiving data of customers and creating, recording, using, and disclosing private data of such customers in the ordinary course of business, and (2) "business associates" requiring the use of said private data (ie. Para. 0176), said method comprising the steps of: assigning digital identities to the contracting parties (ie. Para.

0117-0118 and 0164); generating a database of digital identities (ie. Para 0166-0168 or 0695); providing an electronic interface (ie. Para 0117) accessible to said digital identities **to facilitate** negotiating and entering binding multilateral contractual agreements among at least one of said covered entities and a plurality of said business associates pursuant to the terms of said MBAC template; determining if disclosing of the private data of customers is required (inherent in the program when the user “requests” access to private data); determining whether a contracting party is found in said certified database (Inherent in the login process); allowing access to said MBAC database by said contracting parties (inherent when user is identified); creating a multilateral contractual agreement from said MBAC template terms (ie. Fig. 13, Para. 0127, 0609, 0615 and 0619); and storing said multilateral contractual agreements in a database (ie. Para. 0088). Keinsley et al. also teaches that contracting parties can be prompted with legal agreements upon signing in to a system as a user, (as identified above in the certification/MBAC template agreement references above). Keinsley et al also teaches that new or other legal agreements or conditions can be added for which the user will have to agree (ie. Para. 0615). In the least, Keinsley et al. teaches prompting of multiple agreements upon signing into a HIPAA database.

Keinsley et al. fails to teach the additional step of providing self-certification provisions in said MBAC for contracting parties to certify adherence to said privacy standard. However, Smithies provides a document and signature verification system including a sample self-certification form (Fig. 3A). While the sample form does not explicitly state adherence to said privacy standard, it is clear that the self certification

form can be modified to adhere to any contractual agreement. It would have been obvious to one of ordinary skill in the art, at the time of invention of electronic contractual agreements to modify the Keinsley et al. legal agreements to include self certification and electronic signature as taught by Smithies for the fact that self-certification allows agreements that would otherwise not be binding to become binding in a quick, inexpensive, and efficient way.

Keinsley et al. also does not appear to explicitly recite providing a multilateral Master Business Associate Contract (MBAC) template having non-negotiable terms requiring observation of said privacy standard with respect to said private data of a customer. The Federal Registrar teaches that Federal rules require non-negotiable terms that require Observation of privacy standards with respect to customer data. For example, Section 164.530 requires an entity to maintain specific policies and procedures in written or electronic form to protect health information. It would have been obvious to one skilled in the art of contractual agreements to modify the method for creating contracts of Yin with the non-negotiable terms as taught by the Federal Registrar in order to protect the privacy of the medical data of customers. Motivation is evident based on the fact that these agreements are common and any automation would save a great deal of time.

Furthermore, it should be noted that language containing the term “allowing” is interpreted broadly as only being capable of doing. No substantial patentable weight has been given to this term since one may or may not perform this step.

9. **With respect to claims 3 and 7**, the combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teaches all of the limitations of claims 1 and 4, such that Keinsley et al. specifically teaches an electronic interface including interactive means for negotiating additional terms with respect to use or disclosure of said private data. (ie. Para 0117). It should be noted that given the objection and rejections above, the examiner has interpreted interactive means under its broadest reasonable interpretation. Simply the language is interpreted to be a computer or otherwise that is connected to the web/internet capable of facilitating additional negotiation.

10. **With respect to claim 5**, the combination of Keinsley et al., teaches all of the limitations of claims 4 including signing an agreement (i.e. Para. 0622), except for explicitly reciting that additional step of providing self-certification provisions in said MBAC for contracting parties to certify adherence to said privacy standard by providing a self-certification affidavit for self-certification by electronic signature and storing the affidavits in a database.

However, Smithies provides a document and signature verification system including a sample self-certification form (Fig. 3A). While the sample form does not explicitly state adherence to said privacy standard, it is clear that the self certification form can be modified to adhere to any contractual agreement. It would have been obvious to one of ordinary skill in the art, at the time of invention of electronic contractual agreements to modify the Keinsley et al. legal agreements related to privacy of HIPAA regulations to include self certification with electronic signature as taught by



Smithies for the fact that self-certification allows agreements that would otherwise not be binding to become binding in a quick, inexpensive, and efficient way.

11. **With respect to claim 11**, this claim introduces no substantial limitation over that of claims 1 and 4-5, and is therefore rejected under a similar rational. It should be noted that language containing the term “allowing” is interpreted broadly as only being capable of doing. No substantial patentable weight has been given to this term since one may or may not perform this step.

12. **With respect to claims 8 and 13**, the combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teaches all of the limitations of claims 4 and 11, such that Keinsley et al. specifically teaches an interactive means includes means for a covered entity to offer and for a business associate to accept said non-negotiable terms in the MBAC. (i.e. Para 0117, providing for a computer capable of facilitating the offer and acceptance). It should be noted that given the objection and rejections above, the examiner has interpreted interactive means under its broadest reasonable interpretation. Simply the language is interpreted to be a computer or otherwise that is connected to the web/internet capable of facilitating additional negotiation.

13. **With respect to claims 9 and 14**, the combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teaches all of the limitations of claims 4 and 11, such that Keinsley et al. inherently teaches the additional step of: accessing a selected multilateral contractual agreement in said MBAC database for permission to disclose selected private data to, for example, a selected self-certified business associate. In fact, the determination of whether a user has agreed to a contractual agreement is

contingent upon knowing whether your user is authorized. For example, Keinsley teaches storing your agreement. (ie. Para. 0690 and 0695)

14. **With respect to claims 10 and 15**, in the least Keinsley et al. teaches an electronic interface comprising the internet. (i.e. Para 0117)

15. **With respect to claim 12**, the combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teaches all of the limitations of claims 11, such that Keinsley et al. specifically teaches an electronic interface including interactive means for negotiating additional terms with respect to use or disclosure of said PHI data. (i.e. Para 0117; PHI data is the data being stored in HIPAA context). It should be noted that given the objection and rejections above, the examiner has interpreted interactive means under its broadest reasonable interpretation. Simply the language is interpreted to be a computer or otherwise that is connected to the web/internet capable of facilitating additional negotiation.

16. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keinsley et al. (US 2003/0154403) in view of Smithies (5,818,955) and 65 Fed. Reg. 82796 (Dec. 28, 2000) as applied to claim 4 above and further in view of Examiner's Official Notice.**

17. **As per claim 6**, Examiner takes Official Notice that warranty clauses are extremely old and well known in the art of contract negotiations. It would have been obvious to one skilled in the art, at the time of invention for contract negotiations to have a warranty clause in the MBAC since the creation of a warranty clause allows for more complete negotiation and prevents future litigation.

***Conclusion***

18. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply.

Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2006/0174335.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/  
Examiner, Art Unit 3629  
July 16, 2008

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629